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Supreme Court of the United States

OCTOBER TERM, 1935

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., AND THE BALTIMORE GASLIGHT COMPANY,
Petitioners,
vs.
PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, and DUBILIER CONDENSER CORPORATION,
Respondents.

No. 388

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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JOHN B. BRADY,
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Supreme Court of the United States

October Term—1935.

A. G. TRIPLETT, R. M. TRIPLETT, A. NELSON, C. M. TRIPLETT, JR., AND THE BALTIMORE GASLIGHT COMPANY, *Petitioners,* vs. PERCIVAL D. LOWELL, FRANCIS W. DUNMORE, AND DUBILIER CONDENSER CORPORATION, *Respondents.*	No. 388.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Opinions Below.

The opinion of the District Court for the District of Maryland is not reported, but is found at Vol. I, page 263, of the Transcript of Record.

The opinion of the Circuit Court of Appeals (R. Vol. I, p. 417) is reported at 77 Fed. (2d) 556.

Jurisdiction.

The decree of the Circuit Court of Appeals was entered on June 4, 1935 (R. Vol. I, p. 433). Notice of filing the petition for Certiorari was served on August 22, 1935.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (c. 229, 43 Stat. 938; 28 U.S.C.A., §347).

Questions Presented.

1. Where both Courts below have held that respondents are not guilty of unreasonable delay in filing a disclaimer,* shall such finding of fact be reviewed by this Court upon writ of certiorari.

2. Where the Circuit Court of Appeals in one circuit in an initial suit for infringement so interprets the claims of a patent as to hold the same invalid, may the patentees, whom both Courts have held to have acted without unreasonable delay, disclaim such interpretation and, without acquiescing in such decision or disclaiming themselves out of Court, file a second suit in another circuit?

3. Where the Circuit Court of Appeals in an initial suit for infringement of a patent construes the term "means," in the claims, to refer to certain broad features shown in the patent and upon such interpretation holds the claims void for aggregation, may the patentee, not guilty of unreasonable delay, without canceling the claims, adding elements thereto or otherwise changing the language of the claims, assert a narrower interpretation of such term, disclaim the interpretation put upon his claims by said court and bring a second suit in another circuit seeking an interpretation of the term "means" as referring to the features shown and described in the patent and which function in a cooperative manner to constitute invention?

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*District Court, Vol. I, page 45-47; Circuit Court of Appeals, Vol. I, p. 427.

4. Where the Circuit Court of Appeals in an initial suit upon two radio patents directed to the operation of radio broadcast receivers by alternating current without objectionable hum, construes the term "means" in the claim to refer to a rectifier and filter and erroneously assumes that such rectifier and filter transform household alternating lighting current into smooth direct current equivalent to that from a battery and upon that basis holds no invention, although intimating that if fluctuating currents were delivered to the receiving set in the case of one patent and to the grid circuit in the other patent, is the patentee, not guilty of unreasonable delay and having disclaimed such interpretation of his patent, barred from bringing suit in another circuit and showing that in fact the rectifier and filter do not transform the alternating current into the equivalent of battery current, and that fluctuating current with substantial variations unsuitable for use without more are in fact delivered to the defendants' receiving set and to the grid circuit and asking that the term "means" in the claims construed to cover the means shown and described in the patent to make such fluctuating currents usable in the circuits of the receiving set and in the grid circuit without the objectionable hum?

Statement.

The respondents, Lowell and Dunmore, in 1921 made certain inventions (forming the subject matter of the three patents in suit) which made possible the operation of radio broadcast receiving sets from the ordinary household alternating lighting current, instead of from batteries as had been the previous universal practice.

The inventions were published, embodied in full-sized demonstration sets, and submitted to the leading and other receiving set manufacturers, who were urged, unsuccessfully, to become licensees and to place the inventions on the market. After approximately three years of unsuccessful

efforts to induce set makers to put the inventions on the market agreements were made with the respondent Dubilier Condenser Corporation (Vol. I, pp. 371-380), which expended several hundred thousand dollars in commercial development (Vol. I, p. 231); and license agreements were made with several manufacturers. Up to and including 1927 the license fees amounted to $28,000. (Vol. I, p. 337). In the fall of that year the Radio Corporation and its associated companies manufactured and put upon the market large quantities of infringing alternating current operated receiving sets, with the result of substantially destroying the business built up under the patents by the Dubilier Condenser Corporation. (Vol. I, p. 231).

Suit was brought under the three patents against the Radio Corporation in the United States District Court for the District of Delaware. As a result of a protracted trial, Judge Hugh M. Morris, holding the Court, held the two patents* here involved valid and infringed; the third patent was held not infringed. (34 Fed. (2d) 450).

Shortly after the decision of Judge Morris, the United States filed suits against the several respondents asserting ownership of the inventions and seeking to acquire title to each of the three patents. (Vol. II, pp. 475-536). Two of these suits were against respondent Lowell in the Eastern District of New York, three against respondent Dunmore in the District of Columbia, three against respondent Dubilier Condenser Corporation in the District of Delaware, and one against the Morkrum Company, a licensee, in the District of Maine.

At about the same time four interference contests were instituted in the Patent Office against patent 1,455,141 by rival inventors, some backed by powerful companies, seeking to wrest the invention from respondents. (Vol. I, pp. 459, 474).

*Claim 9 of patent 1,635,117 covering the earliest invention, and claims 3 and 14 of patent 1,455,141.

The Radio Corporation appealed to the Circuit Court of Appeals for the Third Circuit from so much of the decree of Judge Morris as held the two patents valid and infringed; plaintiffs took no appeal.

Patent 1,635,117.

The earliest invention, patent 1,635,117, was directed to applying alternating current to the grid circuit of the tube in such manner as to maintain thereon a steady unvarying negative potential, a matter of extreme delicacy since the grid is the most sensitive part of the tube and any variation of potential thereon is repeated in the output circuit in greatly amplified form which is heard in the phones or loudspeaker as a hum. To accomplish his object the patentee disclosed a resistance 18 in the grid circuit shunted by a condenser 19; he also showed a conventional rectifier 13 interposed between the house lighting circuit and the resistance and condenser.

The Circuit Court of Appeals for the Third Circuit (59 Fed. (2) 305), overlooking the function of the resistance and condenser, held that the term "means" in the claim applied to the rectifier 13 and "filter" 19 which it assumed to be like a so-called "Hull" filter, and further assumed that a "Hull" filter would transform the house lighting current into smooth direct current, the full equivalent of the steady direct current formerly derived from a battery. Upon the basis of the latter misconception the Court held in substance that nothing more was involved than employing a well known instrument to transform alternating current into direct current and feeding direct current to the grid circuit.

Respondents believed that in this holding two fundamental errors were involved:

First, in identifying the "means" of the claim as rectifier 13 and condenser 19, whereas the real "means" of the claim are the resistance 18 and small condenser 19.

Second. In assuming that the rectifier 13 and small condenser 19 could function to transform the household lighting current into anything comparable to the required steady voltage as from a battery; and in not recognizing that in fact the rectifier, even in conjunction with a suitable condenser, delivers a rising and falling current, the fluctuations having substantial amplitude which without other means would result in loud hum in the output of the tube. Moreover, the so-called "Hull" filter, which includes one or more inductance coils in addition to one or more condensers and the rectifier, in fact delivers substantial fluctuations unless the number of condensers and induction coils be increased to such an extent that the expense would be prohibitive in ordinary radio receivers, as a result of which a less expensive "Hull" filter is commonly used (as does defendant here) and the fluctuating output delivered therefrom to the grid circuit, the Dunmore invention being employed to derive the required steady grid voltage therefrom.

That the decision of the Circuit Court of Appeals would have been in favor of the patent if it had correctly understood the fact in this respect, is shown by the opinion of the Court, which indicates (p. 310) that the Court believed, as indeed the prior art did, that alternating current on the grid circuit would not do at all, for the Court said

> "substituted alternating current would not do the work of direct current in the tube."

And further (p. 310):

> "Here, as in the Lowell and Dunmore patent, there would be invention and a very important one had the patentee invented all its elements, or had he brought old elements into new cooperative function."

In order to avoid any misconception as to the proper interpretation of the term "means", in the claims, the

respondents, on July 8, 1933, filed in the Patent Office a disclaimer, which in effect merely states that the patentee does not interpret the word "means" as including any means except such as include the resistance 18 shunted by condenser 19, both of which elements are the "means" shown and described in the patent specification.

Patent 1,455,141.

This patent is directed to the operation of the receiver by alternating current. At the date of the invention the prevailing type of receiver was of the so-called regenerative type in which the functions of amplification of both radio and audio frequency and detection were combined. Lowell and Dunmore employed a type in which the three functions of radio amplification, detection, and audio amplification are separated; in the radio frequency portion the weak received modulated carrier wave is amplified, without change, in the detector portion one half of each cycle of the carrier wave is suppressed, and in consequence only the lower frequency modulation is passed on from the output, and in the audio amplification portion the low, i. e., audio frequency modulation, is amplified and delivered to the telephones or loud speaker.

The universal practice prior to Lowell and Dunmore was to use wet and dry cell batteries respectively for the filament and plate circuits of the tubes. To apply 60 or 120 cycle household alternating current to these circuits would destroy the modulation in the radio frequency portion where the amplitude of the power current would be many times that of the carrier wave and its modulation and progressively to build up the amplification of the power current as it passed through successive stages, and so to drown out entirely the desired carrier modulation.

The Circuit Court of Appeals (59 Fed. [2d] 509), construed the term "means" etc. for eliminating hum, designated in the opinion as element "f" of the claims, as

comprising a "mid-point connection" shown in a prior Heising & White patent, and held in effect that Lowell and Dunmore merely applied this mid-point connection to each section of the instrument and attained nothing more than a mere aggregation (pp. 307,308).

Respondents believed that in this holding two fundamental errors were involved:

First, in identifying the "means" as the same midpoint connection for all three sections of the instrument, whereas in the patent the "means" are shown and described as comprising, (a) in the radio frequency portion a midpoint connection 17, a resistance 29 shunted by a condenser in the grid circuit, and a radio frequency transformer or transformers 4, 6, in the output circuit, whereby in that portion of the instrument the weak modulated carrier wave is amplified without impairing the modulation, and such power frequency as may be introduced (by variation of filament temperature, induction upon the circuits or otherwise) is prevented by the radio frequency transformer from passing to the detector, thus in effect raising the level of the carrier modulation and lowering the level of any power frequency, (b) in the detector portion a detector having small inherent ability itself to create hum, such as a crystal 9, and means for reducing the introduction of power frequency, such as bypass condenser 9a (these being the equivalent of the more modern indirect heated tube and a midpoint connection), whereby without impairing the modulation and with or without further amplification, the carrier frequency is suppressed and the modulation only is passed on with minimum or no introduction of power frequency, and (c) in the audio frequency portion a midpoint connection 18, whereby the possible introduction of power frequency is reduced, so that its level is low compared to that of the now very high level of the modulation frequency.

Second, in assuming that the midpoint connection can do more than reduce, more or less, the introduction of power frequency and in not realizing that the true "means" in the several parts of the instrument do involve a "new cooperative relation" (308), and that whereas applying the same means to each portion of the instrument would not prevent signal distortion and cumulative increase of power frequencies, Lowell and Dunmore's several means preserve the integrity of the modulation while separating it from the carrier frequency and progressively raising its level so far above any possible introduced power frequency that the latter cannot be heard.

Had the Circuit Court of Appeals not made the mistaken assumption of fact that nothing more was involved than the mere separation of parts containing already old hum eliminating means, it is believed to be clear from their opinion that the claims would have been upheld. This is shown by the language at page 307:

> "It might be invention if, when operating, some hum should develop in the first section and pass over to the second section, or if hum in these two sections should invade the third section and be suppressed before it reaches the loud speaker by the three hum eliminators coacting to that end. In other words, there might be invention if the hum eliminators, though separately placed, functioned together on the circuits of all sections in eliminating wandering hum."

Indeed in the earlier part of the opinion the Court said (p. 307):

> "This is a highly scientific organization, and this is what Lowell and Dunmore say they invented. Looking at it as they disclose it, that is, looking at it close up without looking at its background, it would appeal to any one as invention. If they had invented this apparatus and all its elements, their invention unquestionably would have been basic; it would have been more than that; it would have

been stupendous, for it would have covered the major portion of the practical radio art as it stands today."

In order to avoid any misconception as to the proper interpretation of the term "means" in the claims, the respondents, on July 8, 1933, filed in the Patent Office a disclaimer which in effect merely states that the patentees do not interpret the word "means" as including any means except such as include the above mentioned means in the several portions of the instrument shown and described in the patent.

During all of the time the appeals to the Circuit Court of Appeals for the Third Circuit were pending the before mentioned suit of the United States to acquire title, and the interference contests were proceeding vigorously.

In the title litigation the suits against the Dubilier Condenser Corporation in Delaware were brought to trial and subsequently appealed to the Circuit Court of Appeals for the Third Circuit. A decision was rendered by the Circuit Court of Appeals in these cases shortly after the decisions of the same Court in the patent suits, and petitions for certiorari were filed by respondents in the patent suits and by the government in the title suit.

An order consolidating the cases for purposes of appeal having been made, and a petition for rehearing having been filed in the Circuit Court of Appeals with respect to patent 1,635,117, it was assumed that appellants' time to apply for a writ of certiorari ran from the date of the denial of the petition for rehearing. This Court, however, denied the petition with respect to patent 1,455,141 because not applied for in time, and denied the other petition without stating the reason (287 U. S. 648 and 650). The petition of the government in the title case was granted October 17, 1932 (287 U. S., 588). The bills of complaint in these cases not only demanded title to the patents but also asked that respondents be treated as trustees and be

made to account for all receipts from the patents. The decision of this Court in these cases was rendered April 10, 1933 (289 U. S., 178), and then counsel for the government advised the parties that the Department of Justice had under consideration the bringing of the suits against Lowell and Dunmore to trial (Vol. I, p. 27) and did not dismiss any of the suits against the parties.

In the meantime plaintiffs-appellants were advised (Vol. I, p. 28) that if disclaimers were filed by respondents, the government, if successful in its litigation, might claim that respondents had rendered themselves liable for destroying or impairing the value of government property (see also prayers of the government bills (Vol. II, pp. 53, 62, 71, 79, 87, 95, 104, 113, 122). These suits were dismissed June 8, 1933 and July 3, 1933 respectively (Vol. II, p. 537). *Five days later the disclaimers were filed* (Vol. II, pp. 446, 458).

The interference cases were terminated shortly thereafter by decrees holding Lowell and Dunmore to be the first inventors of the subject matter of patent 1,455,141.

ARGUMENT.

I.

The Issue Raised by the Petition Is One of Fact.

In *Ensten* v. *Simon Ascher & Co.*, 282 U. S., 445, 453, this Court held that unreasonable delay in filing a disclaimer is a question of fact for the Court or jury to decide. Both Courts below have found that respondents were not guilty of unreasonable delay. (Vol. I., pp. 45-47; Vol. I., p. 427).

II.

There Is No Conflict of Decisions.

No case has been cited by petitioner denying the right of a patentee, defeated in the Circuit Court of Appeals for one circuit, and who has not acquiesced in that decision and who proceeds with reasonable diligence, to sue in another circuit and there seek a contrary decision.

Nor has petitioner cited any case departing from the established rule that in the absence of estoppel, and absence of unreasonable delay the decision of one Circuit Court of Appeals has only the weight of comity in another circuit. *Mast Foos & Co.* v. *Stover Mfg. Co.*, 177 U. S. 485; *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30.

In *Ensten* v. *Simon Ascher & Co.*, 282 U. S. 445, cited by petitioners this Court stated the law as follows (p. 455):

> "When a competent court has declared his pretensions without sufficient foundation, we think good faith and the spirit of the enactment demand that he act with such promptness as the circumstances permit **either to vindicate his position or to relieve the public from further evil effects of his false assertion.**" (Emphasis by counsel.)

We submit that nothing in the *Ensten* case indicates any withdrawal or cancellation of the long established right of a litigant defeated in one circuit to seek a different result in another circuit. (See Appendix A.) On the contrary, we submit, the Ensten decision expressly recognizes that right since it points out the two alternatives open to the patentee "whenever he becomes aware that he has claimed more than he has invented or described," i.e. he must "*either*" "*vindicate his position*" or "relieve the pubilc from further evil effects of his false assertion."

In that case the patentee's claim had been held invalid by a decree of a District Court, from which no appeal was taken. He then (p. 455)

> "continued to hold himself out as possessor of the sole right to 'make, use and vend' under the rejected claim for **nearly two years. Then he abandoned it.**" (Emphasis by counsel.)

In the case at bar, we submit, the respondents have conformed to "good faith and the spirit of the enactment" as well as to the rule laid down in the *Ensten* case.

At the time of the denial of their petitions for certiorari by this Court on October 25, 1932, the government title suit was still pending before this Court undecided. There was grave question, as is indicated by the dissenting opinions in this Court (289 U. S. 178) as to whether respondents had the right to file disclaimers, whether if held not to have title they might still be held to be trustees and any disclaimer filed by them be held effective as to any rights disclaimed, and whether they would not be held liable for any such disposition or impairment of the patent rights. They were so advised, and under the circumstances we submit that good faith required that they await the then pending decision of this Court.

That decision was rendered on April 10, 1933. Even then the individual inventors were not entirely assured, because the government counsel indicated an intention to bring to trial the suits against the inventors in New York and the District of Columbia. (Vol. I., p. 27.) It was not until June 8, 1933 and July 3, 1933 that these suits were dismissed.

During this period also the interference contests further beclouded the situation as to whether any of the several alleged inventors was prior to these patentees.

On July 8, 1933, eighty-nine days after the decision of this Court regarding the title* and five days after the dismissal of the last of the title suits against the inven-

*In *Minerals Separation Ltd.* v. *Butte & Superior Mining Co.*, 250 U. S. 336, 354, a delay of three months after a decision of this court invalidating a certain claim was held not to be unreasonable in view of the fact that the patentees resided in a foreign country.

tors, respondents, we submit in compliance with "the spirit of the enactment" on July 8, 1933, gave notice to the public both that they did not accept or acquiesce in the decisions of the Circuit Court of Appeals for the Third Circuit and that they did not interpret the term "means" as claiming the broad subject matter attributed to them by that court.

We submit that the Courts below were fully justified in finding that respondents proceeded with reasonable promptness in view of the burden and uncertainty of the title litigation, the interference contests, the limited resources of the respondents and the necessity of finding and examining a provable instance of infringement in the new district and giving suitable notice to the infringer.

The disclaimers did not in fact cancel any claims, change the wording thereof or the wording of the specification, nor did they subtract or add any elements, or seek to give any meaning to the claims other than, as stated in the opinion of the Circuit Court of Appeals for the Fourth Circuit: (77 F. [2d] 556, 557; Vol. I, p. 419.)

> "to ensure that the broad language of the claims would be given more definite meaning by reference to the disclosures of the patent so as to cover what is there described, or the equivalent thereof, in accordance with the well-established rule that in interpreting the language of a claim, the words are not to be taken literally but in the sense in which they were used by the inventor as disclosed in his specification. Elevator Supplies Co. *v.* Graham & Norton Co. (C. C. A.) 44 F. (2d) 354; Westinghouse *v.* Boyden Power-Brake Co., 170 U. S. 537, 568, 569, 18 S. Ct. 707, 42 L. Ed. 1136."

Thus the question here reduces to the simple question of the right of a defeated patentee, who has not acquiesced in the unfavorable decision, to proceed in another circuit "with such promptness as the circumstances require."

Not only do we find such right recognized in the *Ensten* case, but we find nothing in *Altoona Publix Theatres Corp.* v. *American Tri-Ergon Corp., et al.*, 294 U. S. 477, inconsistent therewith. There it was held that no invention was involved in employing a fly wheel for imparting uniformity to the motion of a film and that a disclaimer which sought to *add* the fly wheel as an element to certain claims was void and hence the whole patent was void. The case, we submit, has no bearing here because the finding of non-invention in the use of a fly wheel precluded any attempt to save the remaining claims even if the attempt to reissue the patent by way of disclaimer did not preclude such attempt.

The disclaimer there involved was not at all of the type of that here involved, as is asserted in the petition, p. 2. There the patentee instead of standing upon the claim as written sought by way of disclaimer to change his claim to read except when a fly wheel was connected to the film through the "means," thus adding the fly wheel connected to the film, as an element *additional* to the "means," i.e., to "add the fly wheel to the arcuate flexing claim" (294 U. S., 491).

In the instant case the patentees stand upon their claims exactly as written and upon their right to have the term "means" therein construed as by law they are entitled to have them construed, i.e., to be the same as or substantial equivalent of the means shown and described in the specifications (*Westinghouse* v. *Boyden Power Co.*, 170 U. S., 537, 568, 569; *Elevator Supplies Co.* v. *Graham & Norton Co.*, 44 Fed. [2d] 354); their disclaimers go no further than that, as has been recognized by all parties hereto.

Nor is there *any* attempt here to revive an abandoned claim. The disclaimers in this case are not invalid, but are of the type referred to in *Carnegie Steel Co.* v. *Cambria Iron Co.* 185 U. S. 403, 436, where this Court held:

> "If the clauses had the effect of broadening the patent the disclaimer removes the objection. If they did not the disclaimer could do no harm, and cannot be made the subject of criticism."

The disclaimer in the *Carnegie* case is referred to with approval in the decision in the *Altoona Publix Theatres* case. (See footnote 477 U. S., 490).

See also disclaimers in *Minerals Separation Ltd.* v. *Butte & Superior Co.*, 250 U. S., 336, 354; *Marconi Wireless Telegraph Co.* v. *De Forest Radio Telephone & T. Co.*, 243 Fed., 560, 565; *United Chromium Inc.* v. *International Silver Co.*, 60 Fed. (2d), 913, 914; and *Seiberling* v. *Thropp's Sons Co.*, 284 Fed., 746, 756, 757, all of which are referred to with approval in the above cited footnote in the *Altoona Publix Theatres* case.

III.

The Cases Cited in the Petitioner's Argument Pp. 15, 16 Are Not in Point.

In *Hoe* v. *Goss Printing Press Co.*, 31 F (2d) 565, the Court merely held that if plaintiff there desired to proceed further *in that case* it must disclaim within thirty days. No question arose as to the right of the patentee to proced elsewhere without accepting the decision of that Court and nothing in the Court's opinion negatived the right to do so. By inference the decision recognized the right of the plaintiff to abandon further proceedings in that case and proceed elsewhere since it gave plaintiff thirty days in which to decide.

In *Radio Condenser Co.* v. *General Instrument Co.*, 65 F (2d) 458, the District Court held that a delay of *approximately* **five years** *after acquiescing in a decision of the Patent Office that the patentee was not the inventor* was

unreasonable. Apparently the case was not appealed to the Circuit Court of Appeals. In any event no such delay is involved here.

In *Better Packages Inc.* v. *Nashua Package Sealing Co.*, 6 Fed. Supp. 573 and 74 Fed. (2d), 679, where previously a claim had been held to be invalid *the ruling was acquiesced in by plaintiff taking no appeal.* After 83 days a new suit was brought *in the same court.* Apparently no excuse was given as to why appeal was not taken in the first case. The District Court held that the delay was unreasonable. The circumstances, other than above stated, do not appear. The issue was purely one of fact. Certiorari was denied. 295 U. S. ... (#888 October Term, 1934. See 55 S. C., 830.)

In the Ninth Circuit in *Otis Elevator Co.* v. *Pacific Finance Corp.*, 68 Fed. (2d) 664, a special master had found a claim to be invalid for failure to comply with Section 4888 of the Revised Statutes, the claim being so broad as to be ambiguous. *No exception was taken to this finding.* The Circuit Court of Appeals held that:

> "The specific question whether or not a claim invalid only for indefiniteness invalidates the entire patent appears to be an open one."

But the Court also held that the claim there involved covered more than that of which the patentee was the original or first inventor and hence that a disclaimer *was* required. No other excuse was offered by the plaintiff for its delay of **fourteen months** (p. 671) and the ruling of the Court was that under the circumstances of that case the delay of fourteen months was too long.

Thus in all of the cases cited by petitioner the patentee had *acquiesced* in a finding of invalidity instead of "vindicating his position" and the question of delay was merely one of fact.

IV.

Petitioner's Questions Present No Novel Question.

The questions specifically presented by the petition for certiorari (p. 4) are, we submit, already answered by the decisions of this Court.

Petitioners' Question 1 is, we submit, fully answered by the long line of decisions set forth in Appendix A hereof.

Question 2, we submit, is fully answered by the *Ensten* case, and the petition merely seeks to reverse the fact finding of both Courts below that respondents were not guilty of unreasonable neglect or delay.

Question 3 assumes the filing of an inadequate and invalid disclaimer, whereas in the case at bar respondents' disclaimers adequately disclaim the interpretation put upon their claims by the Circuit Court of Appeals for the Third Circuit and without acquiescing in such decision have asserted their right to stand upon their own interpretation of the claims as written and applied to the structures shown and described in the specification. Disclaimers of this type are not invalid. *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403; *Marconi Wireless Telegraph Co.* v. *DeForest Radio Telephone & Telegraph Co.*, 243 Fed. 560; *Minerals Separation Ltd.* v. *Butte & Superior Mining Co.*, 250 U. S. 336, 354; *United Chromium, Inc.* v. *International Silver Co.*, 60 Fed. (2d) 913, 914; *Seiberling* v. *Thropp's Sons Co.*, 284 Fed. 746, 756, 757; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 490.

Petitioners, we submit, merely seek a ruling overturning established law which if applied to this case would mean that the patentees after having their patent upheld in one court, their title confirmed by this court, their priority over other and rival inventors confirmed in burdensome interference contests, would be robbed of all right of redress and their contribution of one or more of the

great advances in the radio art go unrewarded, because of a decision which, while acknowledging the presence of a high degree of invention if the facts were as claimed by the patentee, was based upon a mistaken understanding of the basic facts of operation of the devices in question.

The decision of the Circuit Court of Appeals, we submit, was manifestly in accordance with the facts and the law. There is no conflict of decisions; nor is there any question of public or general importance. *Magnum Co.* v. *Coty*, 262 U. S., 159, 163; *Hamilton Shoe Co.* v. *Wolf Brothers*, 240 U. S., 251, 258. The petition should be denied.

Respectfully submitted,

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of Counsel for Respondent.

September 3, 1935.

APPENDIX

Cases in Which Patents or Trade-marks Held Invalid in One Circuit Subsequently Have Been Held Valid in Other Circuits.

I.

Cases in the Supreme Court prior to the establishment of the Circuit Court of Appeals:

The Barbed Wire Patent, 143 U. S. 275, 12 S. Ct., 443, 36 L. Ed. 154, although no diversity of opinion existed in the lower courts, indicates the practice prior to the act establishing the Circuit Courts of Appeal.

The original patent had been held to be invalid by the Circuit Court for the Northern District of Illinois. *Washburn & Moen Mfg. Co.* v. *Haish*, 4 F. 900. The patent was then reissued and in *Washburn & Moen Mfg. Co.* v. *Fuchs*, 16 F. 661, 667, the Circuit Court for the Eastern District of Missouri held the reissue to be unwarranted and void. Suits were then brought upon the original patent in the Circuit Court for the Northern District of Iowa (*Washburn & Moen Mfg. Co.* v. *Beat 'Em All Barbed-Wire Co.*, 33 F. 261), the patent was again held invalid. The Supreme Court held the original patent to be valid.

II.

Cases in the Supreme Court where the patent was held invalid by the Circuit Court of Appeals in one circuit, and later held valid by the Circuit Court of Appeals in another circuit:

Expanded Metal Co. v. *Bradford*, 214 U. S. 366, 29 S. Ct. 652, 53 L. Ed. 1034. The patent was held to be invalid by the Circuit Court of Appeals for the Third Circuit. *Bradford* v. *Expanded Metal Co.*, 146 F. 984. After the decree in the Circuit Court of Appeals for the Third Circuit,

plaintiff filed a bill against another defendant in the Northern District of Ohio. The District Court (*Expanded Metal Co.* v. *General Fireprobfing Co.*, 157 F. 564), held the patent to be invalid on the authority of the case in the Circuit Court of Appeals for the Third Circuit. On appeal the Circuit Court of Appeals for the Sixth Circuit reversed this finding and held the patent to be valid. *Expanded Metal Co.* v. *General Fireproofing Co.*, 164 F. 849. On certiorari from the decree in the Sixth Circuit the Supreme Court held the patent to be valid.

Diamond Rubber Co. v. *Consolidated Rubber Tire Co.*, 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527. The patent was held to be invalid by the Circuit Court of Appeals for the Sixth Circuit in *Goodyear Tire & Rubber Co.* v. *Rubber Tire Wheel Co.*, 116 F. 363; also by the same court in *Rubber Tire Wheel Co.* v. *Victor Rubber-Tire Co.*, 123 F. 85. In subsequent litigation the Circuit Court of Appeals for the Second Circuit held the patent to be valid. *Consolidated Rubber Tire* v. *Firestone Tire & Rubber Co.*, 151 F. 237; also in *Consolidated Rubber Tire Co.* v. *Diamond Rubber Co.* (C. C. A.) 162 F. 892. The Supreme Court held the patent to be valid.

Dowagiac Mfg. Co. v. *Minnesota Moline Plow Co.*, 235 U. S. 641, 35 S. Ct. 221, 59 L. Ed. 398, did not involve the validity of the patent, but the Circuit Court of Appeals for the Sixth Circuit had held plaintiff to be entitled to defendant's entire profits. *Brennan & Co.* v. *Dowagiac Mfg. Co.*, 162 F. 472. Subsequently the Circuit Court of Appeals for the Eighth Circuit held plaintiff to be entitled only to nominal damages. *Dowagiac Mfg. Co.* v. *Minnesota Moline Plow Co.*, 183 F. 314. The Supreme Court, after stating the law, substantially followed the ruling of the Eighth Circuit but reversed the decree for special reasons.

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403, 36 S. Ct. 357, 60 L. Ed. 713. A suit on the trade-mark "Tea Rose" was dismissed by the Circuit Court of Appeals for

the Fifth Circuit. *Metcalf* v. *Hanover Star Milling Co.*, 204 F. 211. In a suit in the Seventh Circuit filed shortly before the decision in the Fifth Circuit, the Circuit Court of Appeals for the Seventh Circuit upheld plaintiff's rights in part. *Hanover Star Milling Co.* v. *Allen & Wheeler Co.*, 208 F. 513. Because of a diversity upon fundamental questions, the Supreme Court took both cases and decided the questions in dispute.

Railroad Supply Co. v. *Elyria Iron & Steel Co.*, 244 U. S. 285, 37 S. Ct. 502, 61 L. Ed. 1136. In copending cases the patent was held invalid by the Circuit Court of Appeals for the Sixth Circuit. *Railroad Supply Co.* v. *Elyria Iron & Steel Co.*, 213 F. 789, and valid by the Circuit Court of Appeals for the Seventh Circuit. *Railroad Supplies Co.* v. *Hart Steel Co.*, 222 F. 261. The Supreme Court held the patent invalid.

Abercrombie & Fitch Co. v. *Baldwin*, 245 U. S. 198, 38 S. Ct. 104, 62 L. Ed. 240. The original Letters Patent were held invalid by the Circuit Court of Appeals for the Seventh Circuit. *Bleser* v. *Baldwin*, 199 F. 133. The patent was then reissued and the reissue held void by the Circuit Court of Appeals for the Third Circuit. *Grier Bros. Co.* v. *Baldwin*, 219 F. 735. The Circuit Court of Appeals for the Second Circuit then held the reissue patent to be valid. *Baldwin* v. *Abercrombie & Fitch Co.*, 228 F. 895. The Supreme Court held the patent to be valid and subsequently (*Simmons Co.* v. *Grier Bros. Co.*, 258 U. S. 82, 42 S. Ct. 196, 66 L. Ed. 475) upheld an application to reopen the case in the Third Circuit.

T. H. Symington Co. v. *National Malleable Castings Co.*, 250 U. S. 383, 39 S. Ct. 542, 63 L. Ed. 1045. The question was one of priority as between Emerick and Byers. The Circuit Court of Appeals for the Seventh Circuit held that Emerick was prior. *Miner* v. *T. H. Symington Co.*, 229 F. 730. Subsequently the Circuit Court of Appeals for the First Circuit held Byers to be prior. *National Mal-*

leable Castings Co. v. *T. H. Symington Co.*, 230 F. 821. The Supreme Court held Byers to be the prior inventor.

Meccano, Ltd. v. *John Wanamaker*, 253 U. S. 136, 40 S. Ct. 463, 466, 64 L. Ed. 822. The District Court in the Southern District of Ohio upheld the patent. The Circuit Court of Appeals for the Sixth Circuit (*Wagner* v. *Meccano, Ltd.*, 246 F. 603) reversed the District Court and held the patent invalid. Meanwhile suit had been brought in the Southern District of New York where a preliminary injunction was granted and an appeal was taken therefrom. After the decision of the Circuit Court of Appeals for the Sixth Circuit, motion was made before the Circuit Court of Appeals for the Second Circuit to dismiss the New York case. The Circuit Court of Appeals for the Second Circuit (*Meccano, Ltd.* v. *John Wanamaker*, 250 F. 250) denied the motion and subsequently (*Meccano* v. *John Wanamaker*, 250 F. 450) reversed the order granting a preliminary injunction, at the same time expressing the opinion that the patent was invalid. On certiorari the Supreme Court affirmed the Second Circuit, stating that the matter for review was "upon the preliminary order for injunction and we may go no further," and remanded the cause to the District Court for further proceedings.

New York Scaffolding Co. v. *Chain Belt Co.*, 254 U. S. 32, 41 S. Ct. 21, 65 L. Ed. 116. After the Circuit Court of Appeals for the Eighth Circuit had held the patent to be invalid (*New York Scaffolding Co.* v. *Whitney*, 224 F. 452), and the Circuit Court of Appeals for the Third Circuit had held the patent to be invalid (*New York Scaffolding Co.* v. *Liebel-Binney Construction Co.*, 243 F. 577), the Circuit Court of Appeals for the Seventh Circuit held the patent to be valid (*Chain Belt Co.* v. *New York Scaffolding Co.*, 245 F. 747). The Supreme Court held the patent to be invalid.

John E. Thropp's Sons' Co. v. *Seiberling* 264 U. S. 320, 44 S. Ct. 346, 68 L. Ed. 708. The Circuit Court of Appeals

for the Sixth Circuit held two claims invalid. *Firestone Tire & Rubber Co.* v. *Seiberling,* 257 F. 74. After qualified disclaimers, the Circuit Court of Appeals for the Third Circuit held the patent as qualified by the disclaimers valid. *Seiberling* v. *John E. Thropp's Sons' Co.,* 284 F. 746. The Supreme Court held the patent to be invalid.

Corona Cord Tire Co. v. *Dovan Chemical Corp.,* 276 U. S. 358, 48 S. Ct. 380, 72 L. Ed. 610. The patent was first held invalid by the Circuit Court of Appeals for the Second Circuit. *Dovan Chemical Corp.* v. *National Analine & Chemical Co.,* 292 F. 555. The patent was then held valid by the Circuit Court of Appeals for the Third Circuit. *Dovan Che.* ... *orp.* v. *Corona Cord Tire Co.,* 10 F. (2d) 598. The Supreme Court held the patent to be invalid.

Saranac Automatic Machine Corp. v. *Wirebounds Patents Co.,* 282 U. S. 704, 51 S. Ct. 232, 75 L. Ed. 634. The patent was held invalid by the Circuit Court of Appeals for the Seventh Circuit in *Wirebounds Patents Co. v. H. R. Gibbons Box Co.,* 25 F (2d) 363. Subsequently the Circuit Court of Appeals for the Sixth Circuit held the patent valid and infringed. *Wirebounds Patents Co.* v. *Saranac Automatic Mach. Corp.* 37 F. (2d) 830. The Supreme Court held the patent invalid.

Radio Corp. v. *Radio Engineering Laboratories,* 293 U. S. 1, 54 S. Ct. 752, 55 S. Ct. 66, 79 L. Ed. .... After the Supreme Court had held DeForest to be the prior inventor the Circuit Court of Appeals for the Second Circuit held Armstrong to be the inventor. 66 F. (2d) 768. The Supreme Court upheld DeForest.

III.

Cases in Circuit Courts of Appeals where the patent was first held to be invalid by one Circuit Court of Appeals and later held to be valid by another Circuit Court of

Appeals (omitting cases which reached the Supreme Court):

Maitland v. *B. Goetz Mfg. Co.*, 86 F. 124 (Second Circuit). Stiringer patent held invalid by Circuit Court of Appeals for the Third Circuit. *Maitland* v. *Gibson*, 63 F. 840. Patent then surrendered and reissued by narrowing claim 1. The reissued claim 1 held valid by Circuit Court of Appeals for the Second Circuit.

McNeely v. *Williames*, 96 F. 978 (Third Circuit). Certain claims were held invalid in 1890 by the Circuit Court for the Second Circuit (*Williames* v. *Barnard*, 41 F. 358), the opinion stating that on filing a disclaimer of the claims held invalid complainants were entitled to a decree upon the other claims. Apparently no appeal was taken by the defendant and at that time plaintiff had no right of appeal from the dismissal. For some reason not apparent on the record, a decree was, according to the opinion of the court in the Third Circuit (96 F. 978, page 980), entered on June 11, 1892, without any disclaimer having been filed.

Suit was brought in the Third Circuit on January 27, 1893. Defendant asserted (96 F. 978, page 980) that "The patent in suit is wholly void by reason of unreasonable neglect or delay" to enter a disclaimer. The Circuit Court of Appeals for the Third Circuit held (96 F. 978, page 986), "We must, therefore, hold that the Reid & Billinton apparatus did not anticipate any of the claims of the patent in suit, and consequently that Williames was under no obligation to enter a disclaimer," and held the patent valid.

Westinghouse Electric & Mfg. Company v. *Stanley Instrument Co.*, 133 F. 167 (First Circuit). The patent was held invalid by the Circuit Court of Appeals for the Second Circuit (*Westinghouse Electric & Mfg. Co.* v. *Catskill, etc., Co.*, 121 F. 831), holding plaintiff's attempted antedating proofs to be insufficient. The Circuit Court of

Appeals for the First Circuit upon more complete proofs held the patent valid. So did the Circuit Court of Appeals for the Seventh Circuit in *Diamond Meter Co.* v. *Westinghouse Electric & Mfg. Co.*, 152 F. 704.

Thomson-Houston Electric Co. v. *Black River Traction Co.*, 135 F. 759 (Second Circuit). In this case the patent had been held invalid by the Circuit Court of Appeals for the Second Circuit in *Thomson-Houston Elec. Co.* v. *Union Ry. Co.*, 86 F. 636, and also by the Circuit Court of Appeals for the Sixth Circuit in *Thomson-Houston Elec. Co.* v. *Jeffrey Mfg. Co.*, 101 F. 121. Subsequently the patent was reissued. In the previous litigation (*Thomson-Houston Elec. Co.* v. *Union Ry. Co.*, 86 F. 636) plaintiff urged that the claim contains certain features by implication and therefore was not anticipated. The reissue specification contained a disclaimer limiting the claim to the features in question. It was held that the reissued claim was not for different inventions, and that the claim was valid.

Imperial Bottle Cap & Machine Co. v. *Crown Cork & Seal Co.*, 139 F. 312 (Fourth Circuit). Pending consideration of the case by this court, the Circuit Court of Appeals for the Second Circuit held the patent invalid. *Crown Cork & Seal Co.* v. *Standard Stopper Co.*, 136 F. 841. This court recognizing the doctrine of comity, nevertheless held the patent to be valid.

Pieper v. *S. S. White Dental Mfg. Co.*, 228 F. 30 (1915). Patent held valid and infringed by the Circuit Court of Appeals for the Seventh Circuit. Previously in 1908 the patent had been held invalid by the Circuit Court of Appeals for the Second Circuit. *Pieper* v. *Electro Dental Mfg Co.*, 160 F. 930.

In *Backstay Machine & Leather Co.* v. *Hamilton*, 262 F. 411 (1920), certain claims were held invalid. In a subsequent suit, *Backstay Machine &Leather Co.* v. *Zenite Metal Co.*, 293 F. 23, the Circuit Court of Appeals for the Sev-

enth Circuit held the same claims to be valid and infringed.

In *Wenborne-Karpen Dryer Co.* v. *Cutler Dry Kiln Co.*, 290 F. 625 (1923), the Circuit Court of Appeals for the Second Circuit held the patent void for lack of invention. After the decision in the Second Circuit, the defendant, in a pending suit in the Sixth Circuit, moved to dismiss upon the ground of privity between the parties. The Circuit Court of Appeals in the Sixth Circuit overruled the plea of privity, reversed a decree of the lower court dismissing the bill, and remanded the case for hearing on the merits. *Wenborne-Karpen Dryer Co.* v. *Dort Motor Car Co.*, 14 F. (2d) 378.

In *Franc-Strohmenger & Cowan* v. *Arthur Siegman*, 27 F. (2d) 785, the patent was held valid after it had been held invalid by the Circuit Court of Appeals for the Sixth Circuit, *Forchheimer* v. *Franc, Strohmenger & Cowan*, 20 F. (2d) 553.